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09/996,276	11/27/2001	David B. Donahue	PD-201124	2346

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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER

HAMZA, FARUK

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2155

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/996,276	Applicant(s) DONAHUE ET AL.	
	Examiner Faruk Hamza	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to the amendment filed on February 26, 2007.
Claims 1,17,19,22 and 26 have been amended. Claims 23-24 have been canceled. Claims 1-22 and 25-27 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,17,19,22 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,17,19,22 and 26 recite "unique basic configuration". It is unclear to examiner how basic configuration could be unique.

Claims 1,17,19,22 and 26 recite bi-directional IP communication device identifier (gateway serial number as applicant argues in remark) associated with unique user. It is unclear how gateway serial number is associated with unique user.

Claims 1 and 26 recite the limitation "itself" in line 16 and 24 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 1-8,11-22 and 25-27 rejected under 35 U.S.C. 102(e) as being anticipated by Beser (U.S. Patent Number 6,049,826) hereinafter referred as Beser.

Beser teaches the invention as claimed including creating a new configuration file with a dynamic protocol server allows greater flexibility for configuring cable modems in a data-over-cable system (See abstract).

As to claim 1, Beser teaches a method for automatic configuration of a bi-directional Internet Protocol (IP) communication device to establish an Internet connection, comprising:

automatically broadcasting a request from a bi-directional Internet protocol (IP) communication device selected from either a DSL gateway or cable modem for unique basic configuration details for the IP communication device over an IP network to the Internet and a remote server connected thereto, where said request contains a MAC address and a unique bi-directional IP communication device identifier stored in the IP communication device and associated with a unique user at the server prior to configure (Fig. 5, Fig. 7A-7B, Column 13, lines 25-Column 17, lines 50, Beser discloses requesting for configuration);

receiving said unique basic configuration details including an IP address from the server at said device, where said unique basic configuration details are assigned to said unique user based on said unique bi-directional IP communication device identifier (Fig. 5, Fig. 7A-7B, Column 13, lines 25-Column 17, lines 50, Beser discloses receiving configuration); and

said bi-directional IP communicating device automatically configuring itself with said unique basic configuration details to establish an Internet connection (Fig. 5, Fig. 7A-7B, Column 13, lines 25-Column 17, lines 50, Beser discloses cable modem configuring itself).

Claims 17,19,22 and 26 do not teach or define any new limitation other than above claim 1 and therefore are rejected for similar reasons.

As to claim 2, Beser teaches the method of claim 1, wherein said remote server is a Dynamic Host Configuration Protocol (DHCP) server (Column 13, lines 25-36).

As to claim 3, Beser teaches the method of claim 2, wherein said receiving comprises obtaining said IP address from said DHCP server (Column 16, lines 1-45).

As to claim 4, Beser teaches the method of claim 1, further comprising transmitting a configuration request for additional configuration details (Fig. 7A).

As to claim 5, Beser teaches the method of claim 4, further comprising receiving said additional configuration details specific to said unique user (Column 4, lines 8-25, Column 8, lines 40-55).

As to claim 6, Beser teaches the method of claim 5, further comprising configuring said bi-directional IP communication device with said additional configuration details (Fig. 7).

As to claim 7, Beser teaches the method of claim 1, further comprising, before said broadcasting step, the steps of:

connecting said bi-directional IP communication device to a communication line (Column 9, lines 41-67); and

powering said bi-directional IP communication device on (Column 9, lines 41-67).

As to claim 8, Beser teaches the method of claim 7, further comprising, before said broadcasting step, the step of automatically detecting a communication circuit over said communication line (Column 9, lines 41-67).

As to claim 11, Beser teaches the method of claim 2, wherein the address of the DHCP server is unknown to the IP communication device said broadcasting comprises broadcasting a DHCP Discover request using a TCP/IP broadcast (Column 13, lines 25-67).

Claims 18 and 20 do not teach or define any new limitation other than above claim 11 and therefore are rejected for similar reasons.

As to claim 12, Beser teaches the method of claim 11, wherein said DHCP server validates the request, said receiving comprises acquiring a DHCP offer

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message from the DHCP server broadcast as a TCIP/IP broadcast and accepting the IP address (Column 13, lines 25-Column 16, lines 45).

As to claim 13, Beser teaches the method of claim 12, further comprising, prior to said configuring step, the steps of:

 sending a DHCP Request message to at least the DHCP server (Column 13, lines 25-Column 16, lines 45); and

 receiving a DHCP acknowledge message from the DHCP server (Column 13, lines 25-Column 16, lines 45).

As to claim 14, Beser teaches the method of claim 1, wherein said broadcasting and receiving steps occur automatically without any communication between said bi-directional IP communication device and a client computer coupled to said bi-directional IP communication device.

As to claim 15, Beser teaches the method of claim 1, further comprising, prior to said configuring step, the steps of:

 assigning said unique bi-directional IP communication device identifier to said bi-directional IP communication device (Column 13, lines 25-Column 16, lines 45); and

associating said unique bi-directional IP communication device identifier with said unique user (Column 13, lines 25-Column 16, lines 45).

As to claim 16, Beser teaches the method of claim 15, further comprising generating a configuration table listing bi-directional IP communication device identifiers, associated users and each user's basic configuration details (Column 3, lines 59-Column 4, lines 7).

Claim 21 does not teach or define any new limitation other than above claim 16 and therefore are rejected for similar reasons.

As to claims 25 and 27, Beser teaches a method comprising before said broadcasting step, the step of automatically detecting a dial-tone for the internet protocol (Column 9, lines 40-67, table 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beser as applied above, and further in view of Huotari et al. (U.S. Pub No. 2002/0004935) hereinafter referred as Huotari.

Beser teaches the invention substantially as claimed including creating a new configuration file with a dynamic protocol server allows greater flexibility for configuring cable modems in a data-over-cable system (See abstract).

As to claim 9, Beser teaches the method of claim 1.

Beser does not explicitly teach the claimed limitation of determining Permanent Virtual Circuit (PVC).

However, Huotari teaches the claimed limitation of determining Permanent Virtual Circuit (PVC) (P[0038]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beser by adding functionality for determining Permanent Virtual Circuit (PVC), which provides secure communication to the users. One would be motivated to do so to enhance the system's communication.

As to claim 10, Beser teaches the method of claim 9.

Beser does not explicitly teach the claimed limitation of determining VPI/VC (Virtual Path Identifier/Virtual Channel Identifier) pair for communications.

However, Huotari teaches the claimed limitation of determining VPI/VCI (Virtual Path Identifier/Virtual Channel Identifier) pair for communications (P[0080]-[0081]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Beser by adding functionality for VPI/VCI (Virtual Path Identifier/Virtual Channel Identifier) pair for communications, which provides secure communication to the users. One would be motivated to do so to enhance the system's communication.

5. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Response to Arguments

6. Applicant's arguments have been fully considered but they are not persuasive.

In the remarks applicant argues in substance that; A) Beser does not teach request does not contains unique bi-directional IP communication device identifier (e.g. gateway serial number).

In response to A) Beser teaches request contains gateway/relay agent IP address (See Fig. 6, 130, Column 13, lines 55-65, Table 4). This IP address is interpreted to be bi-directional IP communication device identifier. Therefore teaching of Beser meets the claimed limitation.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll -free).

Faruk Hamza

Patent Examiner

Group Art Unite 2155



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER